



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/007,093	01/14/98	ANAND	N 1038-765-MIS

SIM & BURNEY  
SUITE 701  
330 UNIVERSITY AVENUE  
TORONTO ON M5G 1R7  
CANADA

HM11/1222

EXAMINER
NOLAN, P

ART UNIT	PAPER NUMBER
1644	

AIR MAIL

DATE MAILED: 12/22/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/007,093

Applicant(s)

ANAND et al.

Examiner

1644

Group Art Unit

1644

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 30 days MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-25 and 27-28 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-25 and 27-28 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

Serial Number: 09/007,093  
Art Unit: 1644

2

### Part III DETAILED ACTION

1. Applicant is notified that the CRF in this case was entered, however, a correction was needed to properly enter the CRF. The changing of the spelling of the word "Aplication" to Application under (vii) Prior Application Data.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121.

Group I. Claims 1-11 and 27-28, drawn to a recombinant conjugate antibody molecule, classified in Class 530, subclass 387.3.

Group II. Claims 12-25, drawn to a nucleic acid molecule, a method of making a polypeptide using said nucleic acid molecules in a vector, said vector expressed in a host cell, classified in Class 536, subclass 23.1 and Class 435 subclasses 69.1, 325 and 320.1.

The inventions are distinct, each from the other because of the following reasons:

The inventions as grouped in Groups I and II are distinct, each from the other, because they represent different inventive endeavors. The antibody in Group I and the nucleic acid molecule in Group II are distinct physically and chemically. The inventions of these groups have biologically distinct and unrelated structure and function and are separately classified. Therefore, they are patentable one over the other.

5. Because a search of these two distinct inventions would not be co-extensive with a search of the others, an examination and search of two or more inventions in a single application would constitute a serious undue burden on the examiner.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).


Serial Number: 09/007,093  
Art Unit: 1644

8. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Nolan whose telephone number is (703) 305-1987. The examiner can normally be reached on Monday through Thursday from 8:00 am to 5:30 pm.

10. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Christina Chan, can be reached at (703) 305-3973. The FAX number for our group, 1644, is (703) 305-7401. Any inquiry of a general nature relating to the status of this application or proceeding should be directed to the Group receptionist, whose telephone number is (703) 308-0196.

Patrick Nolan, Ph.D.  
December 21, 1998

  
CHRISTINA Y. CHAN  
SUPERVISORY PATENT EXAMINER  
GROUP 1800-1640